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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,998

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Andreas Eipper

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4347

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EXAMINER

LEE, DORIS L

ART UNIT

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1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/587,998	EIPPER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Doris L. Lee	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080416</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Double patenting 1***

2. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 9 and 10** of copending **Application No. 10/587,997** in view of **Dvornic et al (US 2002/016113)**.

Claims 1, 9 and 10 of ‘997 teach a thermoplastic polyester with a hyperbranched polycarbonate and other additives, but fails to teach the hyperbranched polyester.

Dvornic teaches a hyperbranched polyester of the  $A_xB_y$  type ([0008]) where x is at least 1.1 and y is at least 2.1 ([0007]). Dvornic also teaches that polymer compositions comprising highly branched polyester have a lower viscosity and better

shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of '997. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection.

3. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 9 and 10 of commonly assigned copending Application 10/587,997. Specifically, see discussion set forth in paragraph 2 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 10/587,997, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions

were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 2***

4. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12, 13, and 17-21** of copending Application **No. 11/576,646**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12 and 13 of Application '646 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12, 13 and 17-21 of commonly assigned copending Application 11/576,646.

Specifically, see discussion set forth in paragraph 4 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/576,646, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the

commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 3***

6. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 11, 12, 15, 16, and 20-21** of copending Application **No. 11/577,009**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 11, 12, 15, 16 20-21 of Application '009 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 11, 12, 15, 16, and 20-21 of commonly assigned Application 11/577,009.

Specifically, see discussion as set forth in paragraph 6 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,009, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 4***

8. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 5-9, 12-13, and 16-20** of copending **Application No. 11/577,587** in view of **Dvornic et al (US 2002/016113)**.

Claims 1, 5-9, 12-13, and 16-20 of '587 teach a thermoplastic polyester with a hyperbranched polycarbonate and other additives, but fails to teach the hyperbranched polyester.

Dvornic teaches a hyperbranched polyester of the  $A_xB_y$  type ([0008]) where  $x$  is at least 1.1 and  $y$  is at least 2.1 ([0007]). Dvornic also teaches that polymer compositions comprising highly branched polyester have a lower viscosity and better shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of '587. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection.

9. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned Application 11/577,587. Specifically, see the discussion set forth in paragraph 8 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,587, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the



conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 5***

10. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, 17-21** of copending Application **No. 11/577,590**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12-13, 17-21 of Application '590 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 17-21 of commonly assigned Application 11/577,590. Specifically, see the discussion as set forth in paragraph 10 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/577,590, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 6***

12. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 6-11, and 13-14** of copending Application **No. 11/632,711**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 6-11, and 13-14 of Application '711 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 6-11 and 13-14 of commonly assigned Application 11/632,711. Specifically, see the discussion as set forth in paragraph 12 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/632,711, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 7***

14. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, and 15-16** of copending Application **No. 11/659,506**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 and 15-16 of Application '506 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-13 directed to an invention not patentably distinct from claims 1, 5-9 and 15-16 of commonly assigned application 11/659.506. Specifically, see the discussion as set forth in paragraph 14 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application 11/659,506, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 8***

16. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 and 12-13** of copending Application **No. 11/659,625**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 and 12-13 of Application '625 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9 and 12-13 of commonly assigned application 11/659,625. Specifically, see the discussion as set forth in paragraph 16 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/659,625, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this

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application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 9***

18. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,638**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 19-23 and 25 of Application '638 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-13 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,638. Specifically, see the discussion as set forth in paragraph 18 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP

Chapter 2300). Commonly assigned application 11/813,638, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 10***

20. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,833**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14, 19-23 and 25 of Application '833 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 1-13 directed to an invention not patentably distinct from claims 14, 19-23 and 25 of commonly assigned application 11/813,833. Specifically, see the discussion as set forth in paragraph 20 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 11/813,833, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 11***

22. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, and 16-20** of copending Application **No. 11/996,489**.



Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9, 12-13, 16-20 of Application '489 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

23. Claims 1-13 are directed to an invention not patentably distinct from claims 1, 5-9, 12-13 and 16-20 of commonly assigned application 11/996,489. Specifically, see the discussion as set forth in paragraph 22 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/996,489, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Double patenting 12***

24. **Claims 1-13** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 13-14, and 18-20** of copending Application **No. 11/815,238**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 5-9 13-14, 18-20 of Application '238 recite all the components of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25. Claims 1-13 directed to an invention not patentably distinct from claims 1, 5-9, 13-14 and 18-20 of commonly assigned application 11/815,238. Specifically, see discussion as set forth in paragraph 24 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned application 11/815,238, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

28. **Claims 1-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 5,712,336)** in view of **Dvornic et al (US 2002/0161113)**.

**Regarding claim 1**, Gareiss teaches a thermoplastic molding composition (Abstract), comprising

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- A) from 10% to 97.9% by weight of at least one thermoplastic polyester (col. 1, line 8), and
- C) from 0 to 70% by weight of other additives (col. 1, lines 16-17).

However Gareiss does not teach that the thermoplastic molding composition further comprises a component

- B) at least one highly branched or hyperbranched polyester of  $A_xB_y$  type, where  $x$  is at least 1.1 and  $y$  is at least 2.1, or a mixture of these,

Dvornic teaches a hyperbranched polyester of the  $A_xB_y$  type ([0008]) where  $x$  is at least 1.1 and  $y$  is at least 2.1 ([0007]). Dvornic also teaches that polymer compositions comprising highly branched polyester have a lower viscosity and better shear thinning properties for applications than similar compositions containing a chemically similar linear polyester ([0002]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the hyperbranched polyester of Dvornic to the composition of Gareiss. One would have been motivated to do so in order to receive the expected benefit of controlling and changing the ease of processability of the polyester material (Dvornic [0002]). They are combinable because they are concerned with the same field of endeavor, namely thermoplastics. Absent objective evidence to the contrary and based upon the teachings of the prior art, there would have been a reasonable expectation of success.

As to the amount of the hyperbranched polyester, it is the examiner's position that it is a result effective variables because changing them will clearly affect the type of

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product obtained. See MPEP § 2144.05 (B). Case law holds that “discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of this, it would have been obvious to one of ordinary skill in the art to utilize appropriate amounts of hyperbranched polyester to achieve the desired processability of the thermoplastic, including those within the scope of the present claims, so as to produce desired end results.

Modified Gareiss also does not explicitly teach the amounts of each component as recited in the instant claim.

It is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

**Regarding claim 2**, modified Gareiss discloses all the limitations as set forth above. In addition, modified Gareiss teaches that the polymer has a molar mass of about 1,000 to 10,000 (Dvornic, [0024]).

**Regarding claims 3-6**, modified Gareiss discloses all the limitations as set forth above.

As modified Gareiss discloses the hyperbranched polyester as recited in the instant claims above, it is therefore inherent that the hyperbranched polyester has the corresponding glass transition temperature, the OH number and the COOH number as recited in the instant claims since such a property is evidently dependent upon the nature of the composition used. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

**Regarding claims 7-11**, modified Gareiss discloses all the limitations as set forth above.

In addition, modified Gareiss teaches a method of obtaining the hyperbranched polyester using the methods recited in the instant claims (Dvornic, [0014]).

It is noted that claims 7-11 are product-by-process claims, patentability of said claim is based on the recited product and does not depend on its method of production. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

**Regarding claims 12 and 13**, modified Gareiss discloses all the limitations as set forth above.

In addition, modified Gareiss teaches that a fiber, foil or molding can be made (Gareiss, col. 9, lines 63-64) via injection molding (Gareiss, col. 10, lines 36-37).

### ***Conclusion***

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/  
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/  
Supervisory Patent Examiner, Art Unit 1796